

REMARKS/ARGUMENTS

Status of the claims

Claims 1 – 4, 6 – 12, and 16 – 24 are pending in the application. Claim 21 has been amended to comply with the Examiner’s objection.

Introduction

In Examiner’s April 7, 2006 Office Action, Examiner: objected to claim 21 for informalities; rejected all claims under 35 U.S.C. § 103; rejected the 1.131 affidavits of Lopez and Rodriguez as being ineffective to establish conception, diligence, or reduction to practice prior to the 12 May 1999 date of the SEC filing; and raised the issue of a 35 U.S.C. § 102(b) bar for public use or on-sale activity.

Objection to claim 21 for informalities

Examiner objected to claim 21 because of the language “The automated print order system...” and required correction, suggesting “An automated print order system...” Claim 21 has been amended to comply with Examiner’s requirement.

35 U.S.C. § 103 Rejections

Examiner rejects all claims under 35 U.S.C. § 103(a) as being unpatentable over the SEC filing of 12 May 1999 by ImageX.com, downloaded from the Internet on 15 October 2004.

Applicant conceived and reduced to practice the entire invention as claimed prior to May 12, as attested to by the attached 37 C.F.R. § 1.131 affidavit.

The Applicant submits further evidence to corroborate his statements in the aforementioned affidavit. To establish an actual reduction to practice requires a showing that the process actually worked for its intended purpose. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). The inventor must show independent corroborating evidence in addition to his or her own documents, such as testimony of a witness other than the inventor or evidence of surrounding facts and circumstances independent of information received from the inventor. Markman v. Lehman, 987 F. Supp. 25, 30 (D.D.C. 1997).

Under these guidelines, the Applicant is also submitting for consideration by the Examiner a copy of an affidavit from Norma Rodriguez, a procurement agent of a client, KCI, of the Applicant's company. The affidavit was originally submitted in support of patent application No. 09/487,392 (subsequently allowed.) The assertions contained in Ms. Rodriguez's affidavit address the subject matter, and in fact the affidavit explicitly refers to, the instant application. Ms. Rodriguez attests that the documents attached as Exhibits to the aforementioned § 1.131 affidavit result from a series of transactions that occurred while she was employed as procurement agent for KCI, which was during the months of May through October of 1999. The affiant further asserts that during this timeframe, the affiant's company made use of the Applicant's invention to provide printed business cards.

The exhibits prove Applicant's conception and actual reduction to practice prior to the May 12, 1999 SEC filing date. Based on the foregoing evidence, Applicant respectfully requests that the Examiner withdraw all § 103 rejections.

Public Use or On-sale Activity

In response to Examiner's request for information regarding a possible 35 U.S.C. 102(b) bar, Applicant submits a sworn affidavit stating that the first public use or sale of the claimed invention occurred April 19, 1999.

Effectiveness of Rodriguez and Lopez Affidavits

Applicant requests that the errors as to form of the affidavits (e.g. lack of NAFTA/WTO allegation) be held in abeyance pending Examiner's reconsideration.

Conclusion

In view of the foregoing arguments, Applicants respectfully ask that all rejections be withdrawn. Believing that all things raised in the Examiner's April 7, 2006 office action have been addressed, the undersigned respectfully requests that the application be allowed and passed to issue.

Respectfully,



Charles W. Hanor

Registration No. 27,132

Charles W. Hanor, P.C.
750 Rittiman Road
San Antonio, TX 78209
(210) 447-1051 Direct
(210) 842-9500 Cell
(210) 558-9509 Fax
chanor@hanor.com